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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,450	03/28/2005	Karsten Eulenberg	052317-1010	8928

7590 01/09/2007

Scott A Horstemeyer
Thomas Kayden Horstemeyer & Risley
Suite 1750
100 Galleria Parkway
Atlanta, GA 30339

EXAMINER	
KIM, ALEXANDER D	
ART UNIT	PAPER NUMBER
1656	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/529,450	EULENBERG ET AL.	
	Examiner	Art Unit	
	Alexander D. Kim	1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-36* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Application Status

1. Claims 1-36 are pending in the instant case.

This is a re-restriction upon further consideration of the previous Restriction/Election requirement mailed on 04/19/2006 by the Office.

Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-15, 33 and 34, drawn to a pharmaceutical composition comprising a Mipp1 homologous protein and/or functional fragment.

II. Claims 1-15, 33 and 34, drawn to a pharmaceutical composition comprising a nucleic acid encoding Mipp1 homologous protein and/or functional fragment.

III. Claims 1-15, 33 and 34, drawn to a pharmaceutical composition comprising a modulator of nucleic acid encoding Mipp1 homologous protein and/or functional fragment.

IV. Claims 1-15, 33 and 34, drawn to a pharmaceutical composition comprising a modulator of Mipp1 homologous protein and/or functional fragment.

V. Claims 16, 28 and 30, drawn to a method of making medicament containing a nucleic acid encoding a Mipp1 homologous protein, isoform, a fragment or variant.

VI. Claims 16, 25-27 and 29, drawn to a method of making medicament containing a nucleic acid encoding a Mipp1 homologous protein, isoform, a fragment or variant.

VII. Claim 16, drawn to a method of making medicament containing a modulator of nucleic acid encoding a Mipp1 homologous protein, isoform, a fragment or variant.

VIII. Claims 16 and 25-27, drawn to a method of making medicament containing a modulator of Mipp1 homologous protein, isoform, a fragment or variant.

IX. Claim 17, drawn to a method of using nucleic acid molecule encoding protein Mipp1 homologs, an isoform, a fragment or variant to make medicaments.

X. Claims 17 and 22-24, drawn to a method of using Mipp1 homologs, an isoform, a fragment or variant to make medicaments.

XI. Claim 17, drawn to a method of using a modulator of nucleic acid molecule encoding Mipp1 homologs, an isoform, a fragment or variant to make medicaments.

XII. Claims 17 and 22-24, drawn to a method of using a modulator of Mipp1 homologs, an isoform, a fragment or variant to make medicaments.

XIII. Claims 18-21, 33 and 35-36, drawn to a transgenic animal or cell.

XIV. Claims 31-32, drawn to a method of using transgenic animal or cell to make medicament.

XV. Claim 33, drawn to antibodies.

*Each gene or protein in Table 1 is a distinct product, which requires election of a gene or a polypeptide addition to the election of a single Group from above.

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The inventions are linked by the technical feature of a Mipp1 protein. However, this technical feature is not special because it does not constitute an advance over the prior art. Caffrey et al. (1999, FEBS Letters, vol. 442, p. 99-104) teaches a cloning and expression of human MIPP protein (see p. 100, middle). The Group I is a composition comprising a Mipp1 protein whereas Groups II-IV are nucleic acid, modulator of nucleic acid and modulator of Mipp1 protein, respectively, which is distinct from the product of Group I. Groups V-VIII are a method of making medicament. Groups IX-XII are a method of identifying substances using the nucleic acid, polypeptide, nucleic acid modulator, and polypeptide modulator, respectively. Group XIII is a transgenic cell. Groups XIV-XV are a method of making transgenic cell and antibodies, respectively

Notice of Possible Rejoinder

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Election

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander D. Kim whose telephone number is (571) 272-5266. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr Bragdon can be reached on (571) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander Kim
December 27, 2006

KATHLEEN M. KERR, PH.D.
SUPERVISORY PATENT EXAMINER